

REMARKS

Applicants respectfully traverse and request reconsideration. Please note initially that Claims 1 through 63 as shown herein include highlighted notations in brackets and bold font to show the similarities between old Claims 1-31 and new Claims 32-63. The claims as shown are not intended to be amended from those previously presented.

In the previous response, Applicants added claims 32-63 and cancelled, without prejudice, claims 1-31. As noted, “the subject matter presented in new claims 32-63 is similar in scope to that previously presented in claims 1-31 or has full support in the originally-filed application.” (Response filed May 16, 2007, p. 12). In response, the current Office action imposed a restriction requirement requiring Applicants to restrict prosecution to one of: alleged Invention I directed to claims 32-63; and alleged Invention II directed to claims 1-31. (Office action, pp. 2-3). The Office action also constructively elected invention II because of the January 16, 2007 Office action; Claims 32-63 of Invention II stand withdrawn. (Office action, p. 3). Consequently, the Office action states that because there are “[n]o claims to examine and the remarks are directed to the newly added claims that have been withdrawn from consideration”, the May 16, 2007 response is not fully responsive to the January 16, 2007 Office action. (Office action, p. 4).

As to the restriction requirement, the Office action states that Invention I (claims 32-63) is drawn to a method of encoding a set of e-mail addresses using an encoding algorithm to control e-mail message transmission as classified in class 709, subclass 246. (Office action, p. 2). The Office action further states that Invention II (claims 1-31) is drawn to a method of controlling e-mail message transmission over a network as classified in class 709, subclass 206. (Office action, p. 2). The entire rationale for the restriction requirement is found on pages 2-3, ¶ 3 of the Office action where it states the following.

Inventions I, and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as encoding e-mail addresses. Invention II has separate utility such as filtering e-mail messages. See MPEP § 806.05(d).

Applicants respectfully disagree and traverse this restriction requirement.

Applicants kindly remind the Examiner of the examining procedure with respect to restriction requirements. “Under the statute, the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent ... or distinct.” MPEP § 803. “If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” MPEP § 803. “Examiners must provide reasons and/or examples to support conclusions.” MPEP § 803(II). The MPEP further requires the Examiner to identify any and all linking claims that, if allowable, would require rejoinder of the alleged Inventions. *See e.g.*, MPEP §§ 809, 817(B).

Preliminarily, Applicants note that the Office action has not produced a *prima facie* case in establishing that restriction is proper under MPEP Chapter 800. No serious examining burden has been demonstrated by the Office action and the alleged inventions are not believed to be distinct. Further, the Examiner has not identified whether any linking claims exists. In the event the Restriction Requirement is maintained, Applicants preliminarily elect Invention II (claims 1-31) solely because MPEP § 821.03 requires such an election if the restriction requirement is maintained.

I. There Exists No Serious Search Burden Or Any Other Serious Burden On
The Examiner.

Applicants note that the Examiner has classified alleged Invention I into class 709, subclass 246 and alleged Invention II into class 709, subclass 206. Facially this may appear to support a conclusion that there exists a burden on the Examiner. However, Applicants respectfully note that the description of the alleged inventions ignores the language of the claims and appears to be improperly drafted to suit the Office's desire for a restriction requirement. Because the descriptions of the inventions are improper and ignore claim language, the restriction requirement is improper and should be withdrawn.

Applicants respectfully draw the Examiner's attention to the listing of the claims above. In this listing, the claims contain notations offset in brackets and bold font. Specifically, select portions of alleged Invention II (claims 1-31) have been marked to indicate paragraphs so that particular limitations may be referenced with ease. Similarly, select portions of alleged Invention I (claims 32-63) have been marked to indicate, for particular limitations, the basis or support from alleged Invention II. The markings to alleged Invention I utilize the claim numbers and, if applicable, the paragraph numbers, of alleged Invention II. Together, these marking clearly indicate that nearly each and every limitation found in the alleged Invention II can also be found in alleged Invention I. As an example of the significant overlap between subject matter presented in alleged Invention I and alleged Invention II, Applicants note that originally-filed, independent claim 23 (as part of alleged Invention II) requires the "hash coding [of] a first list of e-mail addresses to yield a first list of has coded e-mail addresses". Applicants respectfully submit that hash coding is a type of encoding using, for example, an encoding algorithm. This claim feature alone sufficiently

supports the position that the Office action's characterization of alleged invention II (as one that does not require use of an encoding algorithm) is defective.

Accordingly: (1) the description of each alleged invention was unduly narrow and therefore improper; and (2) any search that was adequate to search alleged Invention I would have been required for alleged Invention II. Both points, independently and together, illustrate that no serious search burden or any other examination burden exists and that restriction is improper and must be withdrawn.

Applicants respectfully submit that the above-referenced markings to claims 1-63 are not part of the claims themselves, but are merely inserted in this paper for the sole purpose of illustrating that the Examiner's characterization of the alleged inventions was improper.

II. The Alleged Inventions Are Not Distinct Under Any Applicable Test.

Applicants initially note that the Examiner has admitted that alleged Invention I and alleged Invention II are related; i.e., they are not independent. (Office action, p. 2, ¶ 3). Accordingly, the alleged inventions should only be restricted if they are distinct and if there is a serious search burden on the Examiner. MPEP §§ 803, 806(A-C).

"Related inventions [i.e., not independent inventions] are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect ... and wherein at least one invention is PATENTABLE ... OVER THE OTHER." MPEP § 802.01(II) (emphasis in original). The MPEP further indicates that "[w]here inventions are independent (i.e., no disclosed relation therebetween), restriction to one of thereof is ordinarily proper[, where] inventions are related as disclosed but are distinct as claimed, restriction may be proper[, and where] inventions are related as disclosed but are not distinct as claimed, restriction is never proper." MPEP § 806(A-C).

Inventions classified as combination and subcombination claims are related; “[a] combination is an organization of which a subcombination or element is a part.” MPEP §§ 806.05, 806.05(a). If inventions are classified as subcombinations “disclosed as usable together in a single combination, and which can be shown to be separately usable, [restriction is usually proper] when the subcombinations do not overlap in scope and are not obvious variants. To support a restriction requirement where applicant separately claims plural subcombinations usable in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and reasons for insisting on restriction are necessary. Each subcombination is distinct from the combination as claimed if: (A) the combination does not require the particulars of the subcombination as claimed for patentability (e.g., to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination. ... Furthermore, restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search.” MPEP § 806.05(d) (emphasis in original).

A. Basic Test.

Preliminarily, Applicants note that the basic test for whether two alleged inventions are distinct requires the Examiner to determine whether “the inventions *as claimed* are not connected in at least one of design, operation, or effect [and whether] one invention is PATENTABLE ... OVER THE OTHER.” MPEP § 802.01(II). Regardless of the characterization used to describe the subject matter of alleged Invention I and alleged Invention II, both alleged inventions enjoy significant overlap and therefore are connected in at least one of design, operation, or effect. Using the Examiner’s characterization of the alleged inventions, both alleged inventions require

the control of an e-mail message transmission. Using the specific analogy to originally-filed claim 23 above, both alleged inventions require the encoding of a set of e-mail addresses using an encoding algorithm. Further, Applicants respectfully submit that the concept of a network is employed in at least claim 24 of alleged Invention II and at least claim 57 of alleged Invention I. Accordingly, these reasons alone support the position that the alleged inventions are not distinct.

B. *Two-Way Test.*

Next, Applicants respectfully note that the specific explanation for why the alleged inventions are distinct appears to suggest that the alleged inventions are related as subcombinations that are disclosed as usable together in a single combination. (Office action, pp. 2-3, ¶ 3). First, this characterization appears to be improper for at least the reason that the Office action does not give any indication as to which single combination the rejection is referencing. Applicants note that “[a] combination is an organization of which a subcombination or element is a part.” MPEP § 806.05(a). This suggests that both of alleged Invention I and alleged Invention II must be capable of being an element of part of a larger organization. Applicants respectfully submit that the alleged larger organization or combination should be disclosed by the Examiner in accordance with MPEP § 803(II) that requires reasons and/or examples to support conclusions.

Second, this characterization appears to be improper for at least the reason that the Office action provides the wrong test for when two alleged inventions are allegedly related as subcombinations that are disclosed as usable together in a single combination. Applicants respectfully note that the test is not that “[t]he subcombinations are distinct from each other if they are shown to be separately usable” as stated by the Office action. (Office action, p. 2). Instead, as noted above, the test is a two-way test as restated below.

If inventions are classified as subcombinations “disclosed as usable together in a single combination, and which can be shown to be separately usable, [restriction is usually proper] when the subcombinations do not overlap in scope and are not obvious variants. (Emphasis added). To support a restriction requirement where applicant separately claims plural subcombinations usable in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and reasons for insisting on restriction are necessary. (Emphasis in original). Each subcombination is distinct from the combination as claimed if: (A) the combination does not require the particulars of the subcombination as claimed for patentability (e.g., to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination. ... Furthermore, restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search.” (Emphasis added). MPEP § 806.05(d).

Applicants respectfully note that the current Office action baldly ignores the additional requirements to the two-way test as highlighted in bold, italics and underlined font above. Moreover, Applicants respectfully reassert the relevant remarks made above where it was shown that the alleged inventions do overlap in scope. As also implicitly noted above, each alleged invention also requires the particulars of the other alleged invention. Thus, because a subcombination is, by definition, an element of a combination, any single combination that Examiner could proffer would necessarily require the common particular element of each subcombination. Assuming that the Examiner’s characterizations of each alleged invention is accurate, each of the alleged inventions contains a common description: controlling e-mail message transmission. This controlling of e-mail message transmission is common to each alleged invention/alleged subcombination and thus is also common to any single combination related to the alleged subcombinations. Other elements are also believed to be common to both alleged inventions. Each of the above reasons, alone and in combination, supports Applicants’ position that the alleged inventions are not distinct. Thus, regardless of the ability of each

alleged invention to have separate utility, the restriction requirement is improper and should be withdrawn.

III. No Linking Claims Have Been Identified And No Affirmative Statement Indicating That No Linking Claims Exist Has Been Put Forth By The Office Action.

The MPEP requires the Examiner to identify any and all linking claims that, if allowable, would require rejoinder of the alleged Inventions. *See e.g.*, MPEP §§ 809, 817(B). Applicants note that at least one linking claim appears to exist. For example, claims 17 and 40 appear to be linking claims. Also claims 30, 43 and 53 also appear to be linking claims. Because no linking claims have been identified, the restriction requirement is also believed to be improper.

IV. Conclusion.

Applicants respectfully submit, based on the above reasons, that the restriction requirement is improper. If, however, the Examiner maintains this restriction requirement, Applicants respectfully request a showing of: (1) the alleged serious examination burden; (2) the alleged single combination of which each alleged invention/subcombination is allegedly a part; and (3) the alleged non-overlap in scope of the alleged inventions/subcombinations and/or combination (i.e., how each alleged invention/subcombination and/or combination can be said to not require the particulars of each subcombination).

Also, if the Examiner identifies an alternate rationale for restriction, Applicants remind the Examiner that the MPEP requires that the Office action provide reasons and/or examples to support each conclusion. MPEP § 803(II).

Finally, Applicants request that the Examiner address whether any linking claims are believed to be present in the alleged inventions.

For the reasons listed above, the restriction requirement is improper. Accordingly, Applicants submit that the response filed May 16, 2007 was fully responsive to the prior Office action.

Applicants respectfully submit that the claims are in condition for allowance and respectfully request that a timely Notice of Allowance be issued in this case. The Examiner is invited to contact the below listed attorney if the Examiner believes that a telephone conference will advance the prosecution of this application.

Respectfully submitted,

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